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Jay S. Walker

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/654,933	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49-62 and 80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 49-62 and 80 is/are rejected.
- 7) ☒ Claim(s) 55-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 49-62 and 80 are pending. Claims 49, 61, 62, and 80 have been amended in this communication filed 02/04/10 entered as Response After Non-Final Action and Request for Extension of Time.
2. The IDS filed 10/30/09 has been considered and entered.
3. The 35 USC 112, Second Paragraph Rejections have been overcome in part for claims 49, 61, 62, and 80 from the Office Action mailed 08/04/09 and are hereby withdrawn in part as set forth here below.
4. The 35 USC 101 Rejection for claim 62 has been overcome by Applicants' amendment and the rejection is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 51-55, 58-62, and 80 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites, "determining a first value" and "determining a second value". It is unclear and vague how the first and second value is determined. The usage of the term "determining" is broad and varied. By definition "determining" is defined as: 1a. To decide or settle (a dispute, for example) conclusively and authoritatively. B. To end or decide, as by judicial action. 2. To establish or ascertain definitely, as after investigation

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or calculation; To reach a decision; resolve”. Claims 61, 62, and 80 have a similar issue.

Claim 49 recites “first value”, “second value”, and “parameter”. One of ordinary skill in the financial arts would be hard put to identify a “first value”, “a second value”, and a “parameter”. Such “values” and “parameters” are broad, varied and constantly changing. Claims 51-55, 58-62, and 80 have a similar issue (See Office Action mailed 06/30/06).

Independent claims 49 and 62 reciting “determining a first value for a parameter of a credit account; determining a second value for the parameter” is interpreted very broadly. The usage of the terms “value” and “parameter” are considered to be indefinite because no “value amount” is given and a value by definition is “a fair return or equivalent in goods, services, or money for something exchanged, the monetary worth of something: marketable price” and “parameter” in its broadest sense is defined as “an arbitrary constant whose value characterizes a member of a system or an independent variable used to express the coordinates of a variable point and functions of them or any of a set of physical properties whose values determine the characteristics or behavior of something”.

Claim 80 recites “receiving an indication that the customer agrees to the modification”. It is vague and indefinite as to what Applicants’ mean by “an indication”. It cannot be determined from the claim language how or what the indication is to show that the customer agrees to the modification. Does the customer say “yes” or sign a form or give some type of gesture?

The dependent claims 50, 56, and 57 are also rejected for their dependency from a rejected base claim.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 50, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckelman in view of "The Strange Behavior of the Credit Card Market" by Calem, Paul S., hereafter Calem.

Claims 49 and 62: Deckelman discloses, A method and a medium encoded with a program for implementing a method , comprising: determining a first value for a parameter of a credit account (pg. 44, para. 7-The first value is 12.5 per cent) the second value is 17.4 percent); determining a second value for the parameter (pg. 44, para. 8- the second value is 17.4 per cent); and calculating by a processing device, a payment, wherein the payment is based on a modification of the parameter from the first value to the second value (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent). Deckelman did not expressly disclose, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value. Calem discloses, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value –Pg. 5, para. 6 –"Card issuers compete by offering special benefits to their cardholders and such examples include rebates on purchases, frequent spender programs (in which card users accumulate "points" that allow them rebates on purchases, and frequent –traveler

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programs (whereby cardholders earn airline-travel mileage each time the card is used and some issuers waive the fixed annual fee for one year for new cardholders and offer higher credit limits to borrowers who make timely payments"). However, Deckelman did disclose, providing an offer to a customer associated with the credit account (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate). It would have been obvious to one having ordinary skill to substitute one known element for another to obtain predictable results. Such as, providing a payment (some type of incentive) to the customer in exchange for the customer agreeing to a modification of the credit account from one value to another value.

Claim 50. Deckelman discloses, The method of claim 49, further comprising: receiving a customer acceptance of the offer (pg. 45, para. 7- It is considered inherent that the customer would accept an offer of a lower rate).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckelman in view of (US 5,297,026) Hoffman.

Claim 51. Deckelman discloses, The method of claim 50, further comprising:

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providing the payment to the customer (pg. 45, para. 7- when the package is offered to the customer and the customer accepts the offer the payment is made to the customer); and modifying the account parameter from the first value to the second value (pg. 44, para. 6-para. 9- The first value is 12.5 per cent and the modified value is 17.4 per cent).

Claim 52. Deckelman failed to disclose, The method of claim 51, wherein an indication of the first value of the parameter of the credit account associated with the customer is stored in a record of a parameter database and where the step of modifying the parameter comprises: substituting the second value for the first value in the record of the parameter database. Hoffman discloses, wherein an indication of the first value of the parameter of the credit account associated with the customer is stored in a record of a parameter database and where the step of modifying the parameter comprises: substituting the second value for the first value in the record of the parameter database (col. 7, line 1-col. 8, line 50 and figs. 3-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have a database for his first value and second value and the calculation of the amount being spent annually.

Claim 53. Deckelman failed to disclose, The method of claim 52, wherein the value of the parameter as stored in the record of the parameter database is used to calculate an amount owed by the customer for activity on the credit account. Hoffman discloses, wherein the value of the parameter as stored in the record of the parameter database is used to calculate an amount owed by the customer for activity on the credit account



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(col. 7, line 1-col. 8, line 36 and fig. 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have a database for his first value and second value and the calculation of the amount being spent annually.

Claims 54, 58, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckleman in view of (US 5,297,026) Hoffman as applied to claims 49-53 above, and further in view of "Developments in the pricing of credit card services"; Canner, Glenn B.; Luckett, Charles A.; Cook, Wayne C.; and Peirce, Mark A., hereafter Canner et al..

Claim 54. Deckelman and Hoffman failed to disclose, The method of claim 49, wherein the account parameter comprises one of an interest rate, a time period of the interest rate, a monthly minimum payment, a credit limit, a grace period, a payment amnesty, and a late fee. Canner et al discloses, wherein the account parameter comprises one of an interest rate, a time period of the interest rate, a monthly minimum payment, a credit limit, a grace period, a payment amnesty, and a late fee (pg. 26, para. 4 –"grace period of twenty to thirty days"), pg. 35, para. 2-"grace period", pg. 28, para. 2 –variable rate plans and interest rates, and pg. 30, para. 2 (credit line)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Canner et al because such a modification would allow Deckelman to have an interest free "grace period" and a lower rate on a

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credit account. The type of information is given very little patentable weight because it is considered “non functional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious”. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ 2d, 1862, 1864 (Fed. Cir. 2004). *In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Statements of intended use do not serve to distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 4778 F.2d 958, 959, 152 USPQ 235, 238 (CCPA 1967).

Claim 58. Deckelman discloses, The method of claim 49, wherein the step of calculating the payment comprises: calculating a payment, wherein the payment is based on the modification of the parameter from the first value to the second value and information associated with the customer associated with the credit account (pg. 44, para. 9).

Claim 59. Deckelman discloses, The method of claim 49, wherein the second value of the parameter is more favorable to a credit account issuer associated with the credit account (pg. 45, para. 6).

Claim 60. Deckelman discloses, The method of claim 49, wherein the second value of the parameter is more profitable to a credit account issuer associated with the credit account (pg. 45, para. 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of Deckelman and further in view of "The Strange Behavior of the Credit Card Market" by Calem, Paul S., hereafter Calem.

Claim 61. Hoffman discloses, A storage device (col. 3, line 15); a processor in communication with the storage device, the storage device storing a program for controlling the processor; and the processor operative with the program (col. 3, lines 15-25 and line 65-col. 4, line 2):

Hoffman failed to disclose, determine a first value for a parameter of a credit account; determine a second value for the parameter; calculate a payment, wherein the payment is based on a modification of the parameter from the first value to the second value; and provide an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value. Deckelman discloses, determine a first value for a parameter of a credit account (pg. 44, para. 7-The first value is 12.5 per cent) the second value is 17.4 percent); determine a second value for the parameter (pg. 44, para. 8- the second value is 17.4 per cent); and calculate a payment, wherein the payment is based on a

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modification of the parameter from the first value to the second value (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent). Deckelman did not expressly disclose, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value. Calem discloses, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value –Pg. 5, para. 6 –“Card issuers compete by offering special benefits to their cardholders and such examples include rebates on purchases, frequent spender programs (in which card users accumulate “points” that allow them rebates on purchases, and frequent –traveler programs (whereby cardholders earn airline-travel mileage each time the card is used and some issuers waive the fixed annual fee fro one year for new cardholders and offer higher credit limits to borrowers who make timely payments”). However, Deckelman did disclose, providing an offer to a customer associated with the credit account (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate). It would have been obvious to one having ordinary skill to substitute one known element for another to obtain predictable results. Such as, providing a payment (some type of incentive) to the customer in exchange for the customer agreeing to a modification of the credit account from one value to another value.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deckelman in view of (US 5,297,026) Hoffman and further in view of "The Strange Behavior of the Credit Card Market" by Calem, Paul S., hereafter Calem.

Claim 80. Deckelman discloses, A method, comprising:  
determining a current value for a parameter of an existing credit account, in which the existing credit account is associated with a customer (pg. 44, para. 7-a current value is 12.5 per cent); determining a value for the parameter that is not the same as the current value (pg. 44, para. 8- the value is 17.4 percent); and calculating, by a processing device, a payment (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent). Deckelman did not expressly disclose providing an offer to the customer, in which the offer comprises an offer to provide the payment to the customer if the customer agrees to a modification of the parameter from the current value to the value that is not the same as the current value. Calem discloses, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value –Pg. 5, para. 6 – "Card issuers compete by offering special benefits to their cardholders and such

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examples include rebates on purchases, frequent spender programs (in which card users accumulate “points” that allow them rebates on purchases, and frequent –traveler programs (whereby cardholders earn airline-travel mileage each time the card is used and some issuers waive the fixed annual fee for one year for new cardholders and offer higher credit limits to borrowers who make timely payments”). However, Deckelman did disclose, providing an offer to a customer associated with the credit account (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate). It would have been obvious to one having ordinary skill to substitute one known element for another to obtain predictable results. Such as, providing a payment (some type of incentive) to the customer in exchange for the customer agreeing to a modification of the credit account from one value to another value. Deckelman failed to disclose, receiving an indication that the customer agrees to the modification; and providing the payment to the customer after receiving the indication. Hoffman discloses, receiving an indication that the customer agrees to the modification (col. 3, lines 53-61); and providing the payment to the customer after receiving the indication (col. 4, lines 3-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have an incentive to offer credit card customers for the purchase of goods and services if they are in good standing with the use of their credit cards. However, it is obvious that a person if the person agrees to a modification of an account to give some type of indication that they are in agreement.

***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter:

Claims 55-57 reciting the second value is selected based on information associated with the customer associated with the credit account, the customer information comprising a customer rating, and the customer rating being based on at least one of a past payment history for the credit account, information obtained from a credit reporting agency, and an income of the customer

Claims 55-57 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stowe, John D.; "Gauging the benefits and costs of automated billing".

***Response to Arguments***

Applicant's arguments filed 02/04/10 have been fully considered but they are not persuasive.

Issue no. 1; Applicants' argue: The focus during examination of claims for compliance with the requirement for definiteness of 35 USC 112, Second Paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more or suitable language or modes of expression are available. MPEP §

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2173.02. This argument has been considered but the issue is the clarity as to what Applicants' mean by certain terminology in the claim language. For example, the terms "determining a first value for a parameter" since there is not any calculation being performed for determining to get a first value and a second value. The calculating does not occur until the third step in the body of the claims. "(Claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily)". In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). "Although claims are interpreted in light of the Specification limitations from the Specification are not read into the claims". In re Van Geuns, 26 USPQ2d 1057(CAFC 1993).

Issue no. 2: Applicants' argue: It is impermissible in law to require that a claim "describe" the invention which is the role of the disclosure portion of the specification, not the role of the claims ...". Response: The role of the claims is to claim that which Applicant(s) regard as the invention and not to obscure that which Applicant(s) consider to be the invention. The claim language may be considered to be clear to the Applicants', however, someone else reading the claims skilled in the art would not know what Applicants' mean by "determining a first value" or determining a second value" or "parameters" as written in the claim limitations. There is nothing found in Applicants' Specification to determine by one of reasonable skill in the of finance or credit or loans to know which value is considered the first value or which value is considered the second value by the Applicants'. The Applicants' are respectfully requested to point out



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in the Specification and/or drawings where the "first value" and the "second value" is found.

Issue no. 3: Applicants' argue: The rejection of the conditional statement in claims 41, 61, and 62. However, this argument is now considered moot in view of the Applicants' amendment to claims 41, 61, and 62.

Issue no. 4: Applicants' argue: "receiving an indication". The Office Action alleges that it is "vague and indefinite as to what Applicants' mean by 'an indication'" solely because the claim itself does not state "how or what the indication is." The Office Action does not provide substantial evidence that support a prima facie case of indefiniteness. The mere finding that the claim does not specify a particular type of indication is legally insufficient to support the rejection. It is impermissible in law to require that a claim "describe" the invention, which is the role of the disclosure portion of the specification, not the role of the claims. See Orthokinetics; \$3 Inc. To the extent the Examiner is concerned that "indication" is broad, breadth is not to be equated with indefiniteness. See In re Miller; SmithKline Beecham; MPEP § 2173.04. Whether Applicants' agree with the appropriateness of the examples or not, the Examiner's ability to articulate examples of what the Examiner submits are "indications" undermines the determination that the term "indication" is fatally unclear. See In re Robins. For at least these reasons, Applicants respectfully submit that no prima facie case of indefiniteness has been established with respect to any of the pending claims based on the Examiner's objection to use of the term "indication." Response: These arguments have been considered but are not persuasive based on there is not anything

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found in Applicants' disclosure (Specification) that indicates any "indication" has occurred or how or what the indication is supposed to be in claiming the invention. This leaves a person to guess what Applicants' mean by receiving an indication. Is the indication that the customer agrees with the offer or that the customer disagrees with the offer?

Issue no. 5: Applicants' argue: Deckelman does not teach or suggest a customer agreeing to a modification of a parameter for an offered payment to the customer and Applicants' submit that no prima facie case of anticipation has been established based on Deckelman for any of the independent claims 49 or 62 has been considered but is not persuasive. Response: This argument is considered moot in view of Applicants' amendment to claims 49 and 62.

Issue no. 6: Applicants' argue: The Office Action alleges, at page 6, that Deckelman teaches calculating a payment based on a modification of a parameter of a credit account from a first value to a second value has been considered but is not persuasive. Response: Claims 49 and 62: A method and a medium encoded with a program for implementing a method, comprising: determining a first value for a parameter of a credit account (pg. 44, para. 7-The first value is 12.5 per cent) the second value is 17.4 percent); determining a second value for the parameter (pg. 44, para. 8- the second value is 17.4 per cent); calculating by a processing device, a payment, wherein the payment is based on a modification of the parameter from the first value to the second value (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent); and providing an offer to a customer associated with the credit account,

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wherein the offer comprises an offer to provide the payment to the customer in exchange for the customer agreeing to the modification of the parameter from the first value to the second value (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate).

Claim 50. The method of claim 49, further comprising: receiving a customer acceptance of the offer (pg. 45, para. 7- It is considered inherent that the customer would accept an offer of a lower rate).

Issue no. 7: Applicants' argue: The cited references do not correct the deficiencies of Deckelman, as stated and Wilcox is not a proper Section 103(a) reference because its earliest potential priority date (which Applicants' understand is April 2, 1999) which is after the effective filing date of the present application which was filed March 12, 1997 and claims priority to U.S. Application No. 08/815,224 now U.S. Patent No. 5,970,478) has been considered. It is interpreted that Hoffman discloses the claim limitations that Deckelman does not disclose. Such as claims 52, 53, 61, and 80 and Canner discloses the claim limitations of claim 54. The arguments regarding the Wilcox reference are now considered to be moot.

Applicants' fail to appreciate the breadth of the claims. In particular, determining a first value for a parameter, determining a second value for a parameter, and receiving an indication that the customer agrees.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on a Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Ella Colbert/  
Primary Examiner, Art Unit 3694

April 19, 2010